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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,658	05/11/2001	Bernhard Riepler	RIEPLER (PCT)	7006

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1077 Northern Boulevard
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EXAMINER

FISCHMANN, BRYAN R

ART UNIT PAPER NUMBER

3618

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,658

Applicant(s)

RIEPLER, BERNHARD

Examiner

Bryan Fischmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-63 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 59 and 60 is/are rejected.
- 7) ☒ Claim(s) 58 and 61-63 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Acknowledgements

1. The amendment (paper 8) filed 3-3-2004 has been entered

Specification

2. The disclosure is objected to because of the following:

A) The following recited phrases are unclear, awkwardly worded, and/or grammatically incorrect:

1) In the third to last line of page 4 of paper 8, it is believed that the word "of" should be added before the word "a".

2) The upper portion of page 6 of paper 8 refers to claim 53. This reference to claim 53 is objected to, as since many claims have been canceled, the final claim numbering will be such that what is now claim 53, will not be claim 53 upon issue of the patent, when claims are renumbered. In general, claims are not referred to in the specification, as the claims are subject to being amended, or renumbered.

3) The second line of page 9 of paper 8, as amended, recites "The binding system has at least one the binding element 11...".

This recitation is considered to be unclear and awkwardly worded.

4) The middle of page 11 of paper 8 recites "Figures 7 and 8". As best understood, these figures had been renumbered to Figures 1 and 2.

See also an additional recitation to Figure 7 within parenthesis about 5 lines below this recitation.

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5) Similar to the above rejection, the second line of page 12 of paper 8 recites "Figs. 7 and 8".

Drawings

3. This drawings filed 3-3-04 are informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Objections

4. Claim 1 is objected to because of the following:

A) Subparagraph (c) of claim 1 is labeled with a "copyright symbol".

Claim Rejections - 35 USC § 112 .

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 59 and 60 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant regard as his invention.

A) Claim 59 recites "The pivotable binding system of claim 58, further comprising an energy storage device connected to at least one of the hinge mechanism and biased against against an upward pivoting movement of a heel end of the tread surface relative to the sports device".

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The term "tread surface" has been defined by the specification as reference number 5. From examination of originally filed Figure 7, the "heel end" of tread surface 5 is connected to sole shoe 6 which in turn is connected to guide member 43, which in turn is connected to the "sliding or rolling body" 3. Since these components appear to be rigidly connected and allow no relative movement, or "pivoting" between them, it is considered unclear how the heel end of the tread surface (5) "pivots" relative to the sports device. Also the above recitation mentions the "hinge mechanism", which has been defined as reference number 68. Since reference number 68 is located toward the front of the sport device, it is considered unclear how reference number 68 could influence "pivoting" of the heel portion (rear portion) of the tread device.

Allowable Subject Matter

7. Claim 58 would be allowable if rewritten or amended to overcome the claim objections set forth in this Office action.
8. Claims 61-63 would be allowable if rewritten to overcome the claim objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Examiner's Comments

9. The amendment (paper 8) has overcome all specification, drawing and claim objections made in the first action, and the 101, 112 and 102 rejections.

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10. The "remarks" section of the amendment listed above (paper 8) recites "The specification has been formally amended...to limit the description to the elected Figures 7 and 8...applicant reserves the right to file a divisional application covering the non-elected Figs. 1-6.

Although the Examiner could find nothing to prevent Applicant from deleting large portions of material corresponding to non-elected species, it is not clear that this material may be later added, as this may constitute new matter, since the material being added was previously deleted, and therefore, there is no "continuity" of disclosed material. Applicant may wish to carefully consider the "legal aspects" of attempting to later add deleted material corresponding to non-elected species in a "child", or divisional application. If Applicant later attempts to "read" this material on a divisional application, the Examiner will consult with an expert in this area before allowing this material to be added.

Conclusion

11. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bryan Fischmann 5-1-1
BRYAN FISCHMANN
PATENT EXAMINER